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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/037,916 | 03/10/1998 | NOBUHIKO NISHIO | P8287-8002 | 7683 |

7590 05/30/2003

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EXAMINER

BACKER, FIRMIN

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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3621

DATE MAILED: 05/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/037,916

Applicant(s)

NISHIO ET AL.

Examiner

Firmin Backer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 29, 2003 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 13-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Read (EFTPOS: electronic funds transfer at point of sale: ELECTRONICS & COMMUNICATION ENGINEERING JOURNAL NOVEMBER/DECEMBER 1989, pp 263-270) in view of Harrop (New electronics for payment: IEE REVIEW OCTOBER 1989, pp 339-342), Schuler et al. (Schuler hereinafter: WO 90/15382) and Powers (US PAT. 5,521,362).

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4. **Re claim 13, Read** discloses an electronic purse system having all of the features claimed except for the explicit disclosure of (a) the second terminal group which does not perform ciphering/deciphering of the information related to money, (b) the claimed access control program, and (c) a transferring unit for transferring an amount of money requested from a vendor from said first purse to said second purse as electronic money: *a first terminal group (i.e., ATM) which can transfer money to an IC card; wherein each terminal in the first group includes a first ciphering/deciphering unit (i.e., encryption/decryption system); (2) a second terminal group (i.e., telephone); and an IC card including a first purse (i.e., a secret level), a second level (i.e., a free level), and a second ciphering/deciphering unit (i.e., encryption/decryption system) for the first purse.* However, as shown by Harrop, it is well known in the art to use a prepayment card for payphones and the prepayment card does not perform ciphering and deciphering of the information related to money. Thus, it would have been obvious to one of ordinary skill in the art to modify the electronic purse system of Read by adopting the teaching of Harrop (i.e., by replacing the second level of Read with the prepayment phone card of Harrop) to facilitate the use of the smart card by eliminating ciphering/deciphering steps for a transaction which does not require high security. Further, the electronic purse system of Read modified by Harrop would inherently work as claimed, i.e., performing cipher/decipher the information for the transaction between the first terminal group and IC card and without performing cipher/decipher the information for the transaction between the second terminal group and IC card. Still further, Schuler discloses the use of an access control program (i.e., *Access control*) including a first purse access program (i.e., *Access application zone*), a second purse access program (i.e., *Unprotected zones*), and a selecting step program (e.g., to access one of two zones, there should

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be a selecting step based on the information provided to IC card), wherein the first purse access program (i.e., *Access application zone*) can access both the first and second purse to transfer money from the first purse to the second purse but a second terminal group cannot access to the first access program to minimize the loss of the fund. Thus, it would have been within the level of ordinary skill in the art to modify the electronic purse system of Read by adopting the teachings of Schuler to facilitate the use of the smart and to minimize the loss of the fund when the card is lost or stolen. Still further, Powers (col. 1, line 63-col. 2, line 10) teaches the use of a transferring unit for transferring an amount of money requested from a vendor from a first purse (e.g., a first register of a memory) to a second purse (e.g., a second register of the memory) to provide protection for the user from withdrawing of an unauthorized amount of money by an unscrupulous vendor. Thus, it would have been within the level of ordinary skill in the art to modify the electronic purse system of Read by adopting the teaching of Powers to further enhance the security of the electronic purse system.

5. **Re claims 14-29, Read** discloses an IC card having all of the features claimed except for the explicit disclosure of (a) making a payment from the second purse without performing ciphering/deciphering of the information related to money, (b) the claimed access control program, and (c) a transferring unit for transferring an amount of money requested from a vendor from said first purse to said second purse as electronic money: *an IC card including a first purse (i.e., a secret level) having a first ciphering/deciphering means (i.e., encryption/decryption system) and a second level (i.e., a free level) and a second level (i.e., a free level)*. However, as shown by Harrop, it is well known in the art to use a prepayment card for various terminals (i.e.,

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payphones, vending machines and ticket machines) and the prepayment card does not perform ciphering and deciphering of the information related to money. Thus, it would have been obvious to one of ordinary skill in the art to modify the IC card of Read by adopting the teaching of Harrop (i.e., by replacing the second level of Read with the prepayment card of Harrop) to facilitate the use of the smart card by eliminating ciphering/deciphering steps for a transaction which does not require high security. Further, the IC card of Read modified by Harrop would inherently work as claimed, i.e., performing cipher/decipher the information for the transaction between the first terminal group and IC card and without performing cipher/decipher the information for the transaction between the second terminal group and IC card. Still further, a recitation of the intended use of the claimed invention (e.g., "for storing a first amount of money") must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use (e.g., EEPROM used for making the IC card of Read), then it meets the claim. Still further, Schuler discloses the use of an access control program (i.e., *Access control*) including a first purse access program (i.e., *Access application zone*), a second purse access program (i.e., *Unprotected zone*), and a selecting step program (e.g., to access one of two zones, there should be a selecting step based on the information provided to IC card), wherein the first purse access program (i.e., *Access application zone*) can access both the first and second purse to transfer money from the first purse to the second purse but a second terminal group cannot access to the first access program to minimize the loss of the fund. Thus, it would have been within the level of ordinary skill in the art to modify the electronic purse system of Read by adopting the teachings of Schuler to facilitate the use of the smart and to minimize the

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loss of the fund when the card is lost or stolen. Still further, Powers (col. 1, line 63-col. 2, line 10) teaches the use of a transferring unit for transferring an amount of money requested from a vendor from a first purse (e.g., a first register of a memory) to a second purse (e.g., a second register of the memory) to provide protection for the user from withdrawing of an unauthorized amount of money by an unscrupulous vendor. Thus, it would have been within the level of ordinary skill in the art to modify the electronic purse system of Read by adopting the teaching of Powers to further enhance the security of the IC card applicable to the electronic purse system.

Response to Arguments

6. Applicant's arguments filed July 31st, 2002 have been fully considered but they are not persuasive.

a. It is noted that the amendment and the arguments offer by the Applicant in this response, are the same amendment and arguments offered in the response in paper no. 28 on July 28th, 2002. Since there is virtually no change in the Applicant's argument and amendment, the Examiner's response remain the same.

b. Applicant argues that Read, Harrop, Schuler and Power taken either alone or in combination fail to disclose teach or suggest a first purse a second purse or an access control program that includes a first purse access program access step for the first purse using the second ciphering/deciphering unit and access step for the second purse without the second ciphering/deciphering unit during executing the first program. Examiner

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respectfully disagrees with application characterization of Read, Harrop, Schuler and Power taken alone or in combinations' inventive concept. Schuler teaches an inventive concept related to a debit card having two accounts. An account that is access restricted and one that is not restricted. The restricted account required a PIN to access and the less restricted account does not require a PIN access code. Now the debit card in Schuler inventive concept is equivalent to applicant IC and the two accounts in Shuler's inventive concept are also equivalent to the purses in applicant's disclosure. The first purse in applicant disclosure can be access through an access control program that is included in the first purse. The restricted account in Schuler inventive concept also use an access control program in order to address issue of confirmation to the cardholder's account. *See summary of the invention and page 6 –page 9 line 34.*

c. Furthermore, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination is obvious since the inventive concepts in the prior arts are in the same environment.

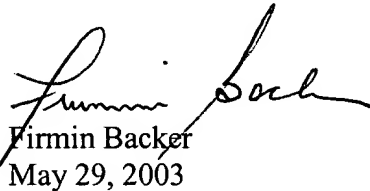
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


Firmin Backer
May 29, 2003